

## **REMARKS**

### **I. Introduction**

Claims 22-44 are currently pending in the present application. Claims 22 and 41 have been amended. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

### **II. Rejection of Claims 22-26, 31-32, 35-38, 40 and 41 Under 35 U.S.C. § 102(b)**

Claims 22-36, 31-32, 35-38, 40 and 41 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,492,223 ("Boardman"). Applicants respectfully submit that Boardman does not anticipate the present claims for the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

Amended claim 22 recites, in relevant parts, a "workpiece carrier for holding . . . substrates during processing of a substrate surface, which carrier includes "at least two process-step-dependent covering elements, wherein a first process-step-dependent covering element is assigned to a side of the base element

opposite the handling element for at least one process step during the processing of the substrate surface, and wherein a second process-step-dependent covering element is assigned to the side of the base element opposite the handling element for at least another process step during the processing of the substrate surface." As clearly noted in the Substitute Specification (e.g., p. 8, l. 8-11), for "the process steps during thin film production . . . , substrate 12 remains in base element 28, and only cover elements 50 are exchanged." In contrast, there is absolutely no suggestion anywhere in Boardman that the upper tray (e.g., 10" shown in Fig. 6) is replaced for different process steps. In fact, Boardman has nothing to with a workpiece carrier for holding substrates during processing of a substrate surface (Boardman "provides interlocking and invertible tray designs for use in shipping and handling of a variety of semiconductor device package types," (col. 3, l. 48-50)), so it is logical that Boardman would not suggest the above-recited feature of amended claim 22.

For at least the foregoing reasons, claim 22 and its dependent claims 23-36, 31-32, 35-38, 40 and 41 are allowable over Boardman.

### **III. Rejection of Claims 22-26, 31-32, 35-38 and 41 Under 35 U.S.C. § 102(b)**

Claims 22-26, 31-32, 35-38 and 41 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 5,794,783 ("Carter"). Applicants respectfully submit that Carter does not anticipate the present claims for the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). If any claimed element is absent from a prior art

reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

Amended claim 22 recites, in relevant parts, a “workpiece carrier for holding . . . substrates during processing of a substrate surface, which carrier includes “at least two process-step-dependent covering elements, wherein a first process-step-dependent covering element is assigned to a side of the base element opposite the handling element for at least one process step during the processing of the substrate surface, and wherein a second process-step-dependent covering element is assigned to the side of the base element opposite the handling element for at least another process step during the processing of the substrate surface.” In contrast, there is absolutely no suggestion anywhere in Carter that the upper tray (e.g., 40 shown in Fig. 2) is replaced for different process steps. In fact, Carter has nothing to with a workpiece carrier for holding substrates during processing of a substrate surface (Carter provides a “die-level test and burn-in flipping tray,” (col. 2, l. 37), which “test and burn-in processes [are] part of the quality control to help insure that the components meet established specifications,” (col. 1, l. 14-16)), so it is logical that Carter would not suggest the above-recited feature of amended claim 22.

For at least the foregoing reasons, claim 22 and its dependent claims 23-36, 31-32, 35-38, 40 and 41 are allowable over Carter.

#### **IV. Rejection of Claims 27 and 39 Under 35 U.S.C. § 103(a)**

Claims 27 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,492,223 (“Boardman”) in view of U.S. Patent 5,540,334 (“Haas”). Applicants respectfully submit that claims 27 and 39 are allowable over the combination of Boardman and Haas for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner contemplated by the claim**. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). Furthermore, in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a) (citing In re Oetiker, 977 F.2d 1443, 1446 (Fed. Cir. 1992)).

Claims 27 and 39 both ultimately depend from claim 22. Furthermore, Haas clearly fails to remedy the deficiencies of Boardman as applied against parent claim 22. Accordingly, claims 27 and 39 are allowable over the combination of Boardman and Haas for the reasons stated in connection with claim 22.

Independent of the above, claims 27 and 39 are allowable over Boardman and Haas because Haas is clearly a non-analogous art to both the present claimed invention and Boardman. Claim 27 recites that "the location hole in the base element includes a hexagonal structure," and claim 39 recites that "the process areas of the covering element includes a hexagonal structure." Applicants note that Haas discloses a transport tray with various hole designs for accommodating glassware of different sizes. It is simply not clear how one of ordinary skill in the art of substrate processing would consider the glassware transport tray of Haas to be even remotely relevant to the present claimed inventions of claims 27 and 39, let alone relevant to the semiconductor device packaging disclosed in Boardman. At best, Haas is a non-analogous art to both the present claimed invention and Boardman, and there wouldn't be any motivation to combine the teachings of Boardman and Haas in an attempt to arrive at the claimed invention of claims 27 and 39. For these additional reasons, claims 27 and 39 are allowable over Boardman and Haas.

**V. Rejection of Claims 28-30  
Under 35 U.S.C. § 103(a)**

Claims 28-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,492,223 ("Boardman") in view of JP 10144824 ("Yoshiharu Takahashi"). Applicants respectfully submit that claims 28-30 are allowable over the combination of Boardman and Yoshiharu Takahashi for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner contemplated by the claim**. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

Claims 28-30 ultimately depend from claim 22. Furthermore, Yoshiharu Takahashi clearly fails to remedy the deficiencies of Boardman as applied against parent claim 22. Accordingly, without passing judgment on the merits of the Examiner's assertions regarding the combination of the applied references, Applicants note that claims 28-30 are allowable over the combination of Boardman and Yoshiharu Takahashi for the reasons stated in connection with claim 22.

**VI. Rejection of Claims 33-34 Under 35 U.S.C. § 103(a)**

Claims 33-34 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,492,223 ("Boardman") in view of EP 0844645 ("Friedman"). It is respectfully submitted that the combination of Boardman and Friedman does not render claims 33-34 obvious, for the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner**

**contemplated by the claim.** See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

Claims 33-34 ultimately depend from claim 22. Furthermore, Friedman clearly fails to remedy the deficiencies of Boardman as applied against parent claim 22. Accordingly, without passing judgment on the merits of the Examiner's assertions regarding the combination of the applied references, Applicants note that claims 33-34 are allowable over the combination of Boardman and Friedman for the reasons stated in connection with claim 22.

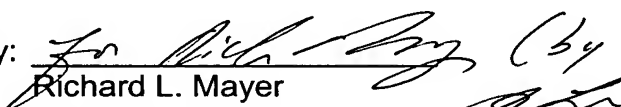
## **VII. Conclusion**

In light of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: September 1, 2004

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